

REMARKS/ARGUMENTS

Claims 44-69 are pending. Claims 44 and 68 are currently amended. Claim 47 is canceled without prejudice. Claim 69 is added and finds support in original claim 43. Amended claim 44 finds support in now canceled claim 47. Claim 68 is amended to remove one of the possible definitions of R^2 . No new matter has been entered.

Regarding the 35 U.S.C. § 103(a) rejection, JP 01 024852 (*Hasuo*) teaches “optionally-substituted” naphthalenedicarboxylic acids and the anhydrides, imides and esters thereof (pg 3, 1st para – formula IV). In contrast, Applicants’ composition *requires* a single substituent on the naphthalene ring (i.e. R^2). *Hasuo* discloses an optional substituent (Q_m) that can attach to the naphthalene at any of six available locations and can be in a quantity of from 0 to 6 separate substituents. Applicants’ composition requires their sole substituent to be at the 4 position of the naphthalene ring only. *Hasuo* discloses a list of naphthalenedicarboxylic acid imides all of which contain no Q substituent anywhere on the naphthalene ring (pg 9, 1st full para). *Hasuo* also fails to disclose any preference for quantity or location of possible naphthalene ring substituents.

Hasuo also teaches an anhydride or imide group at the 1,8- or 2,3- or 1,2- positions of the naphthalene ring (pg 3, 1st para – formula IV). However, the only example provided in the disclosure is of a 2,3-naphthalenedicarboxylic acid-N-(α -carboxymethyl)imide (pg 17, example 9). Again, *Hasuo* fails to disclose any preference for the 1,8- position on the naphthalene ring.

Furthermore, *Hasuo* discloses a potentially infinite laundry list of possible, yet optional naphthalene ring substituents (pg 2) whereas Applicants’ require their sole substituent to be one of only three choices: cyano, $-C(O)NR^5R^{5a}$, or a substituted phenyloxy (see amended claim 1).

In sum, *Hasuo* fails to disclose or suggest the specific combination of the following four elements of Applicants' composition: (1) the 1,8- position only on the naphthalene ring for the imide group, (2) a sole substituent on the naphthalene ring, (3) the sole substituent being at the 4 position only on the naphthalene ring, and (4) the three specific choices for the sole substituent on the naphthalene ring. Therefore, Applicants' composition is non-obvious in light of *Hasuo*; this is in accordance with M.P.E.P. 2144.08(II)(A) which states:

To establish a *prima facie* case of obviousness in a genus-species chemical composition situation, as in any other 35 U.S.C. 103 case, it is essential that Office personnel find some motivation or suggestion to make the claimed invention in light of the prior art teachings. See, e.g., *In re Brouwer*, 77 F.3d 422, 425, 37 USPQ2d 1663, 1666 (Fed. Cir. 1996) ("[T]he mere possibility that one of the esters or the active methylene group-containing compounds... could be modified or replaced such that its use would lead to the specific sulfoalkylated resin recited in claim 8 does not make the process recited in claim 8 obvious 'unless the prior art suggested the desirability of [such a] modification' or replacement.") (quoting *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984)) (emphasis added).

Moreover, Applicants' composition provides superior properties including UV absorption for relatively long periods of time, photo-stability, thermal stability, and resistance to yellowing (pg 3, lines 20-27, and Tables 6-9, pgs 71-75).

Application No. 10/579,441
Reply to Office Action of July 3, 2007

For the reasons discussed above, Applicants submit that all now-pending claims are in condition for allowance. Applicants respectfully request the withdrawal of the rejections and passage of this case to issue.

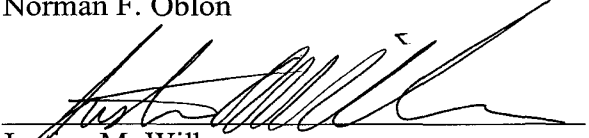
Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.
Norman F. Oblon

Customer Number

22850

Tel: (703) 413-3000
Fax: (703) 413 -2220
(OSMMN 06/04)



Justine M. Wilbur
Registration No. 59,678